

REMARKS

The Official Action of January 10, 2005, and the prior art relied upon therein have been carefully studied. The claims in the application are now claims 19-31, and these claims define patentable subject matter warranting their allowance. Accordingly, the applicant respectfully requests favorable reconsideration and allowance.

The Office Action notes that while applicant has made a claim for foreign priority, applicant has not yet filed a certified copy of the priority document. Accordingly, filed herewith is a certified copy of the European application 03425669.3, filed October 16, 2003, upon which applicant bases the claim for priority. **Acknowledgement by the PTO of the receipt of applicant's papers filed under §119 would therefore now be appreciated.**

The examiner has requested applicant's cooperation in correcting any errors in the specification which applicant might notice. So far, applicant has not noticed any errors. Applicant offers full cooperation.

The original claims have been deleted and have been replaced by new claims 19-31 which applicant believes serve to better particularly point out and distinctly claim the

applicant's invention. The new claims include two independent claims, namely claims 19 and 25, as well as claims 20-24 and 30 which depend from claim 19, and claims 26-29 and 31 which depend from claim 25.

New independent claim 19 includes the previous claim 1 and the subject matter of claim 3. New dependent claim 20 corresponds to the previous claim 2. New dependent claim 21 corresponds to the previous claim 4. New dependent claim 22 corresponds to the previous claim 5. New dependent claim 23 corresponds to the previous claim 7. New dependent claim 24 corresponds to the previous claim 8.

New independent claim 25 includes the previous claim 10 and the subject matter of previous claims 12, 13 and 17. New dependent claim 26 corresponds to the previous claim 11. New dependent claim 27 corresponds to the previous claim 14. New dependent claim 28 corresponds to the previous claim 16. New dependent claim 29 corresponds to the previous claim 18.

new claims 30 and 31 are based on the text at page 4, lines 22-25 of applicant's specification, and are patentable for the same reasons as the claims from which they depend.

Claims 6, 9 and 15 have been rejected under the second paragraph of §112. While applicant does not necessarily agree with the rejection, there are no claims in

the new set of claims which correspond to claims 6, 9 and 15, and therefore there is no need for applicant to further address this rejection at the present time. These claims have been canceled without prejudice<sup>1</sup>.

Claims 10-16 have been rejected under the first paragraph of §112. The rejection is respectfully traversed.

Applicant does not understand the rejection in question, as claim 10 (no longer pending) used the open ended "comprising" transition language, and therefore did not exclude a photo catalyst being present.

Nevertheless, new claim 25, which replaced previous claim 10, does recite the presence of a photo catalyst. Accordingly, applicant need not further address this rejection, which rejection should be withdrawn.

Claims 1-18 have been rejected as obvious under §103 from Cornwell USP 4,495,228 (Cornwell). This rejection is respectfully traversed.

An important technical solution of the present patent application results in the presence of **vitreous granules and calcareous granules with similar sizes**. This technical solution increases the harness and the brightness of

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<sup>1</sup> To a substantial extent, the subject matter of these canceled claims is encompassed by broader claims, and therefore the cancellation of such claims is made without dedication, disclaimer, abandonment, waiver, forfeiture, renunciation, concession or surrender.

the cement paint, according to the technical task of the present application. In fact, it is possible to read in applicant's description of the prior art (page 2, lines 18-19):

Then the presence of a "vehicle" of the cement type, naturally opaque, does not facilitate achievement of a satisfactory paint brightness, when this is required.

In applicant's specification, one can read (page 5, lines 24-25, and page 6, lines 6-10):

The vitreous aggregate 8 improves the properties of the cement paint 1 to a great degree.

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In fact the vitreous granules greatly increase hardness of the cement paint film and therefore the resistance to impact and abrasion of same. Another quality of said granules resides in that they also increase the paint brightness, due to their vitreous nature.

A few lines beyond, one may read (page 6, lines 16-23):

The action of the vitreous granules is enhanced by the fact that the maximum sizes of the vitreous granules and calcareous granules are similar and by the fact that it is advantageously provided for said granules to have real sizes similar or substantially equal to each other.

In this way a uniform and optimal dispersion of the vitreous granules in the mass of the calcareous aggregate may easily take place and in addition said calcareous aggregate cannot by its sizes surpass the action of said microballs of the aggregate or make it fruitless.

This characteristic (Calcareous and vitreous granules having sizes similar to each other) was claimed in previous claim 3, now included in the new independent claim 19.

This characteristic is also mentioned among advantages in the specification (from page 9, line 19, to page 10, line 1):

The invention achieves important advantages. In fact a cement paint is made in which cracks and shrinkage typical of cement are substantially avoided, due in particular to the presence of said vitreous aggregate 8 and also due to the fact that the calcareous aggregate 7 and vitreous aggregate 8 have similar sizes, which will enable a homogenous dispersion of the vitreous aggregate.

The vitreous aggregate has also a cooperative, indeed synergistic, action with the photo catalyst. This synergistic action is increased by the homogenous dispersion of the vitreous aggregate, due to the similar sizes of the calcareous and vitreous aggregates.

In fact, in applicant's specification one can read (page 7, lines 12-15):

In particular the photo catalyst 9 has a partly synergistic action to the vitreous aggregate because it tends to set off and increase brightness of the paint. In fact it exerts a self-cleaning action in the paint helping in keeping the same clean and bright.

Moreover it is possible to read among the advantages (page 10, lines 6-10):

When paint reaches its final condition of dry film, the vitreous aggregate also gives the film hardness and brightness. Brightness in the applied color is also a consequence of the action of photo catalyst 9 giving the paint self-cleaning capacity and helping in greatly reducing the environmental pollution.

Applicant respectfully notes that what an applicant states in his specification is to be accepted by the PTO in the absence of evidence or good reasoning to the contrary. There is no evidence or good reasoning contrary to what is stated in applicant's specification, and the features noted above are not made obvious by the prior art.

At pages 4 and 5 of the first Official Action, is assumed that Cornwell does not specifically disclose the size of the frit, but that it would be obvious to select small sized particles.

However, an important characteristic of the particles described by the present application is to have not only small particles, but also particles of similar sizes, so that the **calcareous aggregate 7 does not hide the vitreous aggregate 8**, and a uniform and optimal dispersion of the vitreous granules in the mass of the calcareous aggregate may easily take place. This also increases the hardness and the brightness of the paint.

Cornwell gives only the maximum size of the particles (usually given is only the maximum or the minimum size of the particles, because they are selected by a mesh).

Clearly, to declare that two kind of particles have the same maximum sizes is not enough to declare that they have similar sizes.

Besides, Cornwell does not have the problem of giving brightness and hardness to the cement surface, but to increase resistance to fire and to corrosion, so the frit is differently utilized and has different characteristic from the vitreous granules of the present invention<sup>2</sup>.

New independent claim 25 now is similar to the new independent claim 19 except for claiming a dry preparation for a cement paint, so the same considerations can be applied to both new claims 19 and 25. Indeed, claim 25 includes the previous claim 12 stating that calcareous and vitreous granules have sizes similar to each other.

Applicant's claims define novel and unobvious subject matter over Cornwell, whereby the rejection should be withdrawn. Such is respectfully requested.

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<sup>2</sup> Applicant notes column 2, lines 39-43, of Cornwell which suggest, contrary to the present invention, that the calcium carbonate "can be used in place of the silica flour", not that these are used together.

Claims 10-12, 17 and 18 have been rejected as obvious from EP 1,162,182 (EP '182). The rejection is respectfully traversed.

First, none of the claims presently pending correspond to claims 10-12, 17 and 18, i.e. main claim 19 includes the subject matter of previous claim 3, not rejected as obvious from EP '182; and main claim 25 contains features of previous claims 12 and 13, not rejected as obvious from EP '182. Applicant accordingly understands that EP '182 is not intended by the PTO to be applicable against applicant's presently pending claims.

Furthermore, applicant respectfully points out that EP '182 suffers from one of the same main defects as Cornwell, i.e. it gives only the maximum size of the particles, and give not the faintest hint that the two types of particles must have similar sizes for the reasons pointed out above and in applicant's specification.

Withdrawal of the rejection based on EP '182 is respectfully requested.

The prior art documents made of record and not relied upon have been noted, along with the implication that such documents are deemed by the PTO to be insufficiently pertinent to warrant their application against any of applicant's claims.



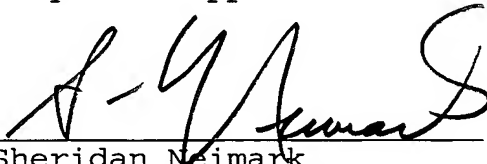
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Favorable reconsideration and allowance are  
earnestly solicited.

Respectfully submitted,

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